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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/652,695

08/31/2000

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INTL-0448-US (P9559)

3818

7590

07/26/2004

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EXAMINER

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ART UNIT

PAPER NUMBER

2614

8

DATE MAILED: 07/26/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/652,695
Filing Date: August 31, 2000
Appellant(s): ESTIPONA, JIM B.

Timothy Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/17/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's grouping of claims is correct.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Advanced Television Enhancement Forum Specification (ATVEF) Version 1.1r26 (2/2/1999)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6,8-12,14-16,17,21-22,24-25 rejected under 35 U.S.C. 103(a) as being unpatentable over the Advanced Television Enhancement Forum Specification (ATVEF) Version 1.1r26, cited by appellant.

As to claim 1, ATVEF discloses transmitting and receiving enhanced television content and Session Description Protocol (SDP) records (pg. 10 par.5-6 and pg. 12 par.6). The reference particularly discloses the use of session announcements that include unique session identifiers (which by definition must be numeric strings) having values that announce the availability of particular broadcasts, which “can be a permanent announcement for all programming on a broadcast channel or for a particular show” (pg.13). The reference does not disclose the availability of an Electronic Program Guide (EPG) as programming on a broadcast channel. However the examiner gives official notice that it is notoriously well known in the art of television broadcasting to broadcast an EPG for the purpose of efficiently navigating through available programming and data services. Therefore it is submitted that it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to use the ATVEF announcement to announce the availability of an EPG for the purpose of making the viewer aware of the EPG's availability.

As to claim 2, ATVEF discloses the use of announcements to announce currently available programming to the receiver. The reference particularly discloses the "owner & session identifier, defined in SDP spec. (RFC 2327)" (pg.13).

Claim 3 is met by that discussed above for claim 1.

Claim 4 is met by that discussed above for claim 1.

As to claim 5, the reference discloses the use of any numeric string for the session identifier. While the reference does not disclose the use of the specific number chosen by the appellant, this is not considered to be a patentable distinction. Therefore it is submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a number indicative of a much earlier time frame in NTP-format for the purpose of using a value that is unlikely to be used (while in NTP-format), as a matter of design choice.

As to claim 6, ATVEF discloses the use of a session name in the SDP announcement (pg.13) as claimed.

Claim 8 is met by that discussed above for claim 1.

Claim 9 is met by that discussed above for claim 2.

Claim 10 is met by that discussed above for claim 1.

Claim 11 is met by that discussed above for claim 1.

Claim 12 is met by that discussed above for claim 5.

Claim 14 is met by that discussed above for claim 1.

Claim 15 is met by that discussed above for claim 1.

Claim 16 is met by that discussed above for claim 5.

Claim 17 is met by that discussed above for claim 1.

Claim 21 is met by that discussed above for claim 1.

Claim 22 is met by that discussed above for claim 1.

Claim 24 is met by that discussed above for claim 1.

As to claim 25, the ATVEF discloses extracting and comparing version numbers, which can be in NTP format, from within the SDP records (pg.13), as claimed.

3. Claims 7,13,18-20,23 rejected under 35 U.S.C. 103(a) as being unpatentable over the ATVEF in view of Gagnon et al (6,522,342), cited by examiner.

As to claim 7, ATVEF discloses everything, as described above, except the claimed "human readable session name indicative of an electronic programming guide". Gagnon et al discloses several examples of session announcement records in announcing the availability of enhanced television content. The reference particularly discloses the use of a human readable session name that is descriptive/indicative of the television enhancement (s=Data Catalog; fig.32B). The reference further particularly discloses the use of a session name that is descriptive/indicative of the broadcast channel carrying the enhancement (s=CNBC; fig.32D). While the reference does not disclose the use of the specific name chosen by the appellant, this is not considered to be a patentable distinction. Therefore it is submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a name descriptive/indicative of a broadcast channel containing an EPG for the purpose of further informing the viewer of the enhancement.

Claim 13 is met by that discussed above for claim 7.

As to claim 18, the ATVEF discloses everything, as described above, except the indication of “whether the enhanced television content includes an” EPG. Gagnon et al discloses an indication of the availability of an EPG in the main user interface (fig.2A (152)).

As to claim 19, Gagnon et al also discloses the use of a version number within the “o” field. The version number indicates the number of previous versions of the enhancement content records (col.35 ln.41-45), as claimed.

As to claim 20, it is inherent within the SDP to process the announcement without regard to the enhancement, if the version number is not higher than the previously received version numbers.

Claim 23 is met by that discussed above for claim 20.

(11) *Response to Argument*

Examiner notes that there is a new examiner of record in this case. A review of previous arguments from all parties of interest has been made and are addressed in further detail herein.

With respect to claim 1, appellant questions if claim 1 is rendered obvious over a single reference, the ATVEF specification. Appellant presents a single argument in the brief, stating that “there is no suggestion to use a session identifier to identify an electronic programming guide transmitted with other content,” that this feature has never been considered or proposed, and that therefore any combination is based on hindsight alone.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

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long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the examiner properly conceded that the primary reference, the ATVEF specification does not explicitly teach availability of an Electronic Program Guide (EPG) as claimed.

The ATVEF specification has been in development for many years, with the presently relied upon version being dated 2/2/99. The purpose of this specification is to provide a single public standard for delivering interactive television experiences using a variety of tools. This is accomplished by providing a specification that sets forth a framework for content formats and delivery mechanisms (see paragraph 1, p. 1). As with many specifications intended to standardize an industry, the framework and transportation methods are intended to be standardized while the data chosen to be transmitted is selectable by different providers. By setting up such a delivery system, it is ensured that multiple providers and receivers will be able

to communicate in a uniform manner while still being able to offer varying products and services.

Turning to the specifics of both the claim language and the ATVEF, it is clearly seen that the ATVEF is intended for “transmitting enhanced television content” (see p. 1, paragraph 1) by “transmitting an announcement for said enhanced television content” (see section 2.2, p. 10, paragraph 2). To quote the referenced section of the ATVEF

“transport type B uses announcements to offer one or more enhancements ...”

These announcements “include a session identifier having a value ... for said enhanced television content” as clearly seen at the top of p. 13.

Notably, the ATVEF explicitly teaches at p. 12, section 3.1.1 that “**announcements are used to announce currently available programming to the receiver**” [emphasis added].

“Currently available programming” is notoriously well known to be presented in the form of an Electronic Programming Guide (EPG) as claimed. However, the ATVEF does not explicitly refer to this as an EPG. To fill the gap, the examiner took Official Notice that broadcasting an EPG is notoriously well known in the art and combined the teachings. The necessity of such a combination does not make the presented claim patentably distinguishable from the ATVEF. As noted above, the ATVEF is a specification merely set out to provide a standardized format for delivery of enhanced television content as explicitly claimed using an announcement and session identifier. The specification stops short of defining an all-inclusive list including what the enhanced content may be and leaves this to the industry to select. Nevertheless, the prior art now of record clearly shows that a multitude of items may be used to enhance television content. See inter alia Gagnon et al. at col. 9:44-62 teaching enhancement of broadcast content by

transmission of program guide data, stock tickers, sports scores, etc. The application of any one of these enhancements using the ATVEF specification framework is both a simple and obvious modification: use an announcement and session identifier in order to provide enhanced content using a standardized format which is portable among diverse systems. In fact appellant readily admits that their system is constructed "compliant with the ATVEF specification" at p.6, line 20 of the original specification and concedes the same in the present brief at p. 2-3. Appellant has merely claimed transmission of an EPG using the ATVEF framework. In appellant's original specification at p. 1 an EPG is defined as "content that is used to determine the programming related information available on a current connection," and as noted above the ATVEF explicitly provides for announcing currently available programming to the receiver. Thus, it is clear that appellant is merely attempting to gain patent protection based on the system the ATVEF specification anticipates. The argument that a system both disclosed and claimed as being anticipated by a prior art specification is allowable merely because the announced available programming is not referred to as an EPG is not found convincing; therefore, it is believed that the rejections should be sustained.

Despite that appellant has not traversed the Official Notice of "broadcasting an EPG for the purpose of efficiently navigating through available programming and data services," examiner provides the following references as teaching these means in accordance with patent procedures for an appeal.

Kondo et al. (6,763,522) – col. 1:24-36, col. 5:12-16, fig. 2A-2D, and col. 10:1-12
indicating a version identifier for an EPG

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Kamen et al. (6,421,067) – col. 1 :29-31, col. 1 :48-53 on additional enhancements with EPGs such as email, and col. 4:60+ through col. 5:3

For the above reasons, it is believed that the rejections should be sustained.

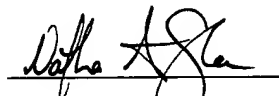
Respectfully submitted,

NAS

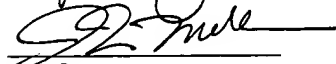
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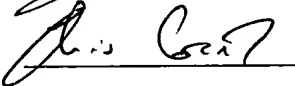
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